

REMARKS

In the outstanding Office Action, the Examiner rejected claims 21-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,429,509 to Hsuan ("Hsuan"); and rejected claim 25 as being unpatentable over Hsuan in view of U.S. Patent No. 6,239,484 to Dore et al. ("Dore"). By this amendment, Applicant has canceled claims 21-24, and has amended claim 25. Claims 1, 2, 4-11, 14-18 and 25 are pending in this application, with claim 25 presented for examination.

Applicant respectfully traverses the Examiner's rejection of claims 21-25 under 35 U.S.C. §§102(e) and 103(a). In order to expedite prosecution, however, Applicant has canceled claims 21-24 and respectfully submits that the rejection of claims 21-24 under 35 U.S.C. § 102(e) is moot.

Regarding the rejection of claim 25 under 35 U.S.C. § 103(a), Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. §2143.03, 8th Ed. (Rev. 2), May 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant 's disclosure." See M.P.E.P. § 2143, 8th Ed. (Rev. 2),

May 2004. At a minimum, the Examiner has not provided sufficient motivation for the combination of the references.

The Examiner states that Hsuan "shows most aspect of the instant invention except 'the second semiconductor chip is thicker or larger than the first semiconductor chip.'" Office Action, page 5. To cure this deficiency, the Examiner states "Fig. 3 of Dore shows a semiconductor device wherein the second semiconductor chip / an upper chip thicker or larger than the first semiconductor chip/ a lower chip." *Id.* The Examiner, however, states, as a motivation for combining Hsuan with Dore, "to accommodate the design specification." Office Action, page 5. According to the Manual of Patent Examining Procedure ("MPEP") § 2143.01:

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art ... [t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

The Examiner merely concludes that one of ordinary skill in the art would have made the combination as a matter of design choice, without citing to a teaching or suggestion in the prior art that provides a motivation for doing so. Accordingly, the Examiner has failed to provide sufficient motivation for combining the references, and has thus failed to establish a *prima facie* case of obviousness. Since the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request that the Examiner withdraw the rejection of claim 25 under 35 U.S.C. § 103(a).

In view of the foregoing, Applicant requests reconsideration of the application and submits that all of the rejections, as detailed above, should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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